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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,995	04/16/2004	Niels Christian Kaarsholm	6573.204-US	9239

23650 7590 08/13/2007

NOVO NORDISK, INC.
PATENT DEPARTMENT
100 COLLEGE ROAD WEST
PRINCETON, NJ 08540

EXAMINER	
BRADLEY, CHRISTINA	

ART UNIT	PAPER NUMBER
1654	

NOTIFICATION DATE	DELIVERY MODE
08/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nnipatent@novonordisk.com

Office Action Summary	Application No.	Applicant(s)	
	10/825,995	KAARSHOLM ET AL.	
	Examiner	Art Unit	
	Christina Marchetti Bradley	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,127-170 and 205-218* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,127-170 and 205-218* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. Claims 1, 127-170 and 205-218 are pending

Claim Objections

2. The objection to claims 127, 145-149 and 155-157 has been withdrawn in light of the amendment filed 6/13/2007.

Claim Rejections - 35 USC § 112

3. Applicant's arguments, see pages 16-18, filed 6/13/2007, with respect to the rejection of claims 127-170 have been fully considered and are persuasive. The rejection of claims 127-170 has been withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 205 and 213-218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,830,999) in view of Franke & Groeneveld (*Transit. Met. Chem.*, **1981**, *6*, 54-6).

7. Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} –bound Zn^{2+} ions in insulin stabilize formulations of insulin hexamers for pharmaceutical use (column 3, lines 57-61). Regarding claim 205, Dunn teaches compositions of fast acting insulin (column 7, line 7). Regarding claims 213-216, Dunn teaches compositions of at least 2 moles of zinc per mole of insulin (column 7, line 19) and at least 22 moles of phenolic compound per insulin hexamer (column 6, line 60). Regarding claims 217 and 218, Dunn teaches compositions with isotonicity agents and buffers (column, 7, line 11). Dunn does not teach the tetrazole zinc ligands of the claimed invention. Franke & Groeneveld teach that tetrazoles can coordinate zinc (abstract).

8. It would have been obvious to one of ordinary skill in the art to substitute the tetrazole ligands of Franke & Groeneveld for the zinc ligands in the insulin hexamers taught by Dunn.

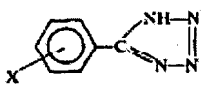
9. In response to Applicant's argument filed 6/13/2007 regarding motivation to combine these references, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1396 (2007) forecloses the argument that a specific teaching suggestion or motivation in the prior art is required to support a finding of obviousness.

10. In response to Applicant's argument that Dunn is directed to the use of ligands able to bind to and stabilize the insulin through zinc binding as opposed to though zinc coordination, Dunn teaches that "these organic carboxylates have structures which form … stronger innersphere coordination bonds to the zinc ions at each His^{B10} site relative to the conventionally-employed acetate ions" (column 3, lines 62-67).

11. Therefore, the skilled artisan would have been motivated to substitute the tetrazoles of Franke & Groeneveld for the zinc ligands in Dunn because Dunn teaches that ligands for the two His^{B10} –bound Zn^{2+} ions in insulin stabilize insulin hexamers for pharmaceutical use (column 3,

lines 57-61) and because Franke & Groeneveld teach that tetrazole containing compounds can be used as a zinc ligand (abstract). There would have been a reasonable expectation of success given that the tetrazole compounds of Franke & Groeneveld are functionally equivalent to the ligands of Dunn based on their ability to coordinate zinc. Thus, claims 1, 205 and 213-218 stand rejected.

12. Claims 127-140, 150-153, and 155-157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,830,999) and Franke & Groeneveld (*Transit. Met. Chem.*, **1981**, *6*, 54-6), as applied to claims 1, 205 and 213-218 above, in further view of Ciarkowski *et al.* (*Org. Mag. Res.*, **1979**, *12*, 631-6). Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} –bound Zn^{2+} ions in insulin stabilize formulations of insulin hexamers for pharmaceutical use (column 3, lines 57-61). Regarding claim 205, Dunn teaches compositions of fast acting insulin (column 7, line 7). Regarding claims 213-216, Dunn teaches compositions of at least 2 moles of zinc per mole of insulin (column 7, line 19) and at least 22 moles of phenolic compound per insulin hexamer (column 6, line 60). Regarding claims 217 and 218, Dunn teaches compositions with isotonicity agents and buffers (column, 7, line 11). Dunn does not teach the tetrazole zinc ligands of the claimed invention. Franke & Groeneveld teach that tetrazoles can coordinate zinc (abstract). Ciarkowski *et al.* teach the following tetrazole compounds:



13. where X can be methyl, $-N(CH_3)_2$, $-NH_2$, $-OCH_3$, -OH, -COOH, -I, -Br, -Cl, -CN, or $-NO_2$ at the 2, 3 or 4 positions. With respect to the formula in claim 127, K is a bond, M is an

arylene, R^{40} is a halogen, -CN, -NO_2, OR^{41}, -$NR^{41}R^{42}$, R^{41} and R^{42} are H or methyl, Q is a bond and T is hydrogen.

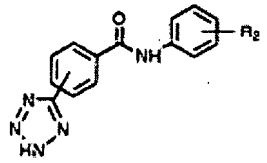
14. It would have been obvious to one of ordinary skill in the art to substitute the tetrazole ligands of Ciarkowski *et al.* for the zinc ligands in the insulin hexamers taught by Dunn.

15. In response to Applicant's argument filed 6/13/2007 regarding motivation to combine these references, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1396 (2007) forecloses the argument that a specific teaching suggestion or motivation in the prior art is required to support a finding of obviousness.

16. In response to Applicant's argument that Dunn is directed to the use of ligands able to bind to and stabilize the insulin through zinc binding as opposed to though zinc coordination, Dunn teaches that "these organic carboxylates have structures which form ... stronger innersphere coordination bonds to the zinc ions at each His^{B10} site relative to the conventionally-employed acetate ions" (column 3, lines 62-67).

17. Therefore, the skilled artisan would have been motivated to substitute the tetrazoles of Ciarkowski *et al.* for the zinc ligands in Dunn because Dunn teaches that ligands for the two His^{B10} –bound Zn^{2+} ions in insulin stabilize insulin hexamers for pharmaceutical use (column 3, lines 57-61) and because Franke & Groeneveld teach that tetrazole containing compounds can be used as a zinc ligand (abstract). There would have been a reasonable expectation of success given that the tetrazole compounds of Ciarkowski *et al.* are functionally equivalent to the ligands of Dunn based on their ability to coordinate zinc. Thus, claims 1, 127-140, 150-153, and 155-157, 205 and 213-218 stand rejected.

18. Claims 127-140, 150-153 and 155-157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,830,999) and Franke & Groeneveld (*Transit. Met. Chem.*, **1981**, *6*, 54-6), as applied to claims 1, 205 and 213-218 above, in further view of Makovec *et al.* (*J. Med. Chem.*, **1992**, *35*, 3633-40). Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} –bound Zn^{2+} ions in insulin stabilize formulations of insulin hexamers for pharmaceutical use (column 3, lines 57-61). Regarding claim 205, Dunn teaches compositions of fast acting insulin (column 7, line 7). Regarding claims 213-216, Dunn teaches compositions of at least 2 moles of zinc per mole of insulin (column 7, line 19) and at least 22 moles of phenolic compound per insulin hexamer (column 6, line 60). Regarding claims 217 and 218, Dunn teaches compositions with isotonicity agents and buffers (column, 7, line 11). Dunn does not teach the tetrazole zinc ligands of the claimed invention. Franke & Groeneveld teach that tetrazoles can coordinate zinc (abstract). Makovec *et al.* teach the following tetrazole compounds:



19. 4-Trz, R2=3,5-COOH; 4-Trz, R2=2,5-COOH; 4-Trz, R2=H, 4-Trz; R2=4-CN; and 4-Trz, R2=4-COOH, wherein Trz=1H-Tetrazol-5-yl. With respect to the formula in claim 127, K is a bond, M is an arylene, R^{40} is $C(O)NR^{41}R^{42}$, R^{41} is H, R^{42} is aryl substituted by R^{46}, R^{46} is COOH or CN, Q is a bond and T is hydrogen.

20. It would have been obvious to one of ordinary skill in the art to substitute the tetrazole ligands of Makovec *et al.* for the zinc ligands in the insulin hexamers taught by Dunn.

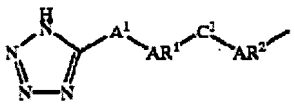
21. In response to Applicant's argument filed 6/13/2007 regarding motivation to combine these references, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1396 (2007) forecloses the argument that a specific teaching suggestion or motivation in the prior art is required to support a finding of obviousness.

22. In response to Applicant's argument that Dunn is directed to the use of ligands able to bind to and stabilize the insulin through zinc binding as opposed to though zinc coordination, Dunn teaches that "these organic carboxylates have structures which form ... stronger innersphere coordination bonds to the zinc ions at each His^{B10} site relative to the conventionally-employed acetate ions" (column 3, lines 62-67).

23. Therefore, the skilled artisan would have been motivated to substitute the tetrazoles of Makovec *et al.* for the zinc ligands in Dunn because Dunn teaches that ligands for the two His^{B10} –bound Zn^{2+} ions in insulin stabilize insulin hexamers for pharmaceutical use (column 3, lines 57-61) and because Franke & Groeneveld teach that tetrazole containing compounds can be used as a zinc ligand (abstract). There would have been a reasonable expectation of success given that the tetrazole compounds of Makovec *et al.* are functionally equivalent to the ligands of Dunn based on their ability to coordinate zinc. Thus, claims 1, 127-140, 150-153, and 155-157, 205 and 213-218 stand rejected.

24. Claims 1, 127-170, and 205-218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,830,999) in view of Olsen *et al.* (US 2003/0229120). Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} –bound Zn^{2+} ions in insulin stabilize formulations of insulin hexamers for pharmaceutical use (column 3, lines 57-61). Dunn does not teach the tetrazole zinc ligands of the claimed invention. Olsen *et al.* teach

novel ligands for the His^{B10} Zn^{2+} sites of the R-state insulin hexamer that are capable of prolonging the action of insulin preparations. The ligands have the formula A-B-C-D-X wherein A is a functionality capable of reversibly coordinating to a His^{B10} Zn^{2+} site of an insulin hexamer and includes compounds of the formula

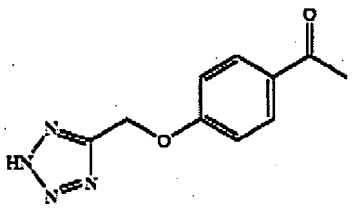


wherein A^1 is a valence bond, C_1-C_6-alkylene, -NH-C(=O)-A^2, -C_1-C_6-alkyl-S-, -C_1-C_6-alkyl-O-, -C(=O)-, or -C(=O)-NH-, wherein any C_1-C_6-alkyl moiety is optionally substituted by R^{1A}; A^2 is a valence bond, C_1-C_6-alkylene, C_1-C_6-alkenylene, or -C_1-C_6-alkyl-O-; R^{1A} is C_1-C_6-alkyl, aryl, wherein the alkyl or aryl moieties are optionally substituted by one or more halogen, cyano, nitro, amino; AR^1 is a valence bond, arylene or heteroarylene, wherein the aryl or heteroaryl moieties are optionally substituted by one or more R^{1B} independently; R^1B is selected from hydrogen, halogen, -CN, -CH_2CN, -CHF_2, -CF_3, -OCF_3, -$OCHF_2$, -OCH_2CF_3, -OCF_2CHF_2, -$S(O)_2CF_3$, -$OS(O)_2CF_3$, -SCF_3, -NO_2, -OR^1C, -NR^1CR^1D, -SR^1C, -$NR^1CS(O)_2$R.sup- .1D, -$S(O)_2NR^1CR^1$D, -S(O)NR^1CR^1D, -S(O)R^1C, -$S(O)_2R^1$C, -$OS(O)_2R^1$C, -C(O)NR^1CR^1D, -OC(O)NR^1CR^1D, -NR^1CC(O)R^1D, -CH_2C(O)NR^1CR^1D, -OC_1-C_6-alkyl-C(O)NR^1CR^1D, -CH_2OR^1C, -CH_2OC(O)R^1C, -$CH_2NR^1CR^1$D, -OC(O)R^1C, -OC_1-C_6-alkyl-C(O)OR^1C, -OC_1-C_6-alkyl-OR^1- C, -S-C_1-C_6-alkyl-C(O)OR^1C, -C_2-C_6-alkenyl-C(=O)OR^1C, -NR^1C-C(=O)-C_1-C_6-alkyl-C(=O)OR- ^{1}C, -NR^1C-C(=O)-C_1-C_6-alkenyl-C(=O)OR^1- C, -C_2-C_6-alkenyl-C(=O)R^1C, =O, -NH-C(=O)-O-C_1-C_6-alkyl, or -NH-C(=O)-C(=O)- -O-C_1-C_6-alkyl, C_1-C_6-alkyl, C_2-C_6-alkenyl or C_2-C_6-alkynyl, which may optionally be substituted with one or more substituents selected from halogen, -CN, -CF_3, -OCF_3, -OR^1C, and -NR^1CR^1D. aryl, aryloxy,

aryloxycarbonyl , arylsulfanyl, aryl-C_1-C_6-alkoxy, aryl-C_1-C_6-alkyl, aryl-C_2-C_6-alkenyl, aroyl-C_2-C_6-alkenyl, aryl-C_2-C_6-alkynyl, heteroaryl, heteroaryl-C_1-C_6-alky- l, heteroaryl-C_2-C_6-alkenyl or heteroaryl-C_2-C_6-alkynyl, of which the cyclic moieties optionally may be substituted with one or more substituents selected from halogen, -C(O)OR^1C, -CH_2C(O)OR^1C, -CH_2OR^1C, -CN, -CF_3, -OCF_3, -NO_2, -OR^1C, -NR^1CR^1D and C_1-C_6-alkyl; R^1C and R^1D independently are hydrogen, -OH, C_1-C_6-alkyl, C_1-C_6-alkenyl, aryl-C_1-C_6-alky- l or aryl, wherein the alkyl moieties may optionally be substituted with one or more substituents selected from halogen, -CN, -CF_3, -OCF_3, -O-C_1-C_6-alkyl, -C(O)-O-C_1-C_6-alkyl- , -COOH and -NH_2, and the aryl moieties may optionally be substituted by halogen, -C(O)OC_1-C_6-alkyl, -COOH, -CN, -CF_3, -OCF_3, -NO_2, -OH, -OC_1-C_6-alkyl, -NH_2, C(=O) or C_1-C_6-alkyl; R^1C and R^1D when attached to the same nitrogen atom may form a 3 to 8 membered heterocyclic ring with the said nitrogen atom, the heterocyclic ring optionally containing one or two further heteroatoms selected from nitrogen, oxygen and sulphur, and optionally containing one or two double bonds; C^1 is a valence bond, C_1-C_6-alkylene, -C_1-C_6-alkyl-O-, -C_1-C_6-alkyl-NH-, -NH-C_1-C_6-alkyl, -NH-C(=O)-, -C(=O)-NH-, -O-C_1-C_6-alkyl, -C(=O)-, or -C_1-C_6-alkyl-C(=O)-N(R^1E) wherein the alkyl moieties are optionally substituted by one or more R^1F ; R^1E and R^1F are independently selected from C_1-C_6-alkyl, aryl optionally substituted by one or more halogen, -COOH; $AR^2$is a valence bond C_1-C_6-alkylene, C_2-C_6-alkenylene, C_2-C_6-alkynylene wherein the alkyl, alkenyl and alkynyl moieties are optionally substituted by one or more R^{2A} independently; arylene, -aryloxy-, -aryloxy-carbonyl-, aryl-C_1-C_6-alkyl, -aroyl-, aryl-C_1-C_6-alkoxy-, aryl-C_2-C_6-alkenyl-, aryl-C_2-C_6-alkynyl-, heteroarylene, -heteroaryl-C_1-C_6- -alkyl-, -heteroaryl-C_2-C_6-alkenyl-, -heteroaryl-C_2-C_6- -alkynyl- wherein the aryl and heteroaryl moieties are optionally substituted by one or more R^{2A}

independently; R^{2A} is C_1-C_6-alkyl, C_1-C_6-alkoxy, aryl, aryloxy, aryl-C_1-C_6-alkoxy, -C(=O)-NH-C_1-C_6-alkyl-aryl, heteroaryl, heteroaryl-C_1-C_6-alkoxy, -C_1-C_6-alkyl-COOH, -O-C_1-C_6-alkyl-COOH, -S(O)$_2$R.sup.2B, -C_2-C_6-alkenyl-COOH, -OR^{2B}, -NO_2, halogen, -COOH, -CF_3, -CN, -$N(R^{2B}R^{2C})$, wherein the aryl or heteroaryl moieties are optionally substituted by one or more C_1-C_6-alkyl, C_1-C_6-alkoxy, -C_1-C_6-alkyl-COOH, -C_2-C_6-alkenyl-COOH, -OR^{2B}, -NO_2, halogen, -COOH, -CF_3, -CN, or -$N(R^{2B}R^{2C})$; and R^{2B} and R^{2C} are independently selected from hydrogen and C_1-C_6-alkyl. See paragraphs 548-568.

25. The elected species



is cited as a preferable form of A (paragraph 0070) as are several other specific compounds that fall within this general formula (examples 399-592).

26. It would have been obvious to one of ordinary skill in the art to combine the A ligands of Olsen *et al.* with the insulin hexamers of Olsen *et al.* and Dunn in the absence of the -B-C-D-X moiety.

27. In response to Applicant's argument filed 6/13/2007 regarding motivation to combine these references, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1396 (2007) forecloses the argument that a specific teaching suggestion or motivation in the prior art is required to support a finding of obviousness.

28. In response to Applicant's argument that Dunn is directed to the use of ligands able to bind to and stabilize the insulin through zinc binding as opposed to though zinc coordination, Dunn teaches that "these organic carboxylates have structures which form ... stronger innersphere coordination bonds to the zinc ions at each His^{B10} site relative to the conventionally-employed acetate ions" (column 3, lines 62-67).

29. In response to Applicant's argument that Olsen is directed to insulin preparations designed to achieve precipitation, the rejection states that it would have been obvious to use the ligands A in the absence of B-C-D-X. In the absence of this extension, precipitation would not occur. In addition, the claims do not exclude the promotion of precipitation. The skilled artisan would have recognized that Olsen *et al.* teach that A groups coordinate zinc and therefore could be used in the place of the ligands taught by Dunn to stabilize the insulin. Thus, claims 1, 127-170, and 205-218 stand rejected.

30. The applied reference Olsen *et al.* has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Double Patenting

31. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

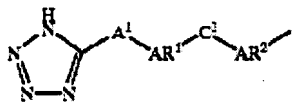
application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

32. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

33. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

34. Claims 1, 127-170, and 205-218 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/226,870. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 127-158, 166 and 170 are generic to all that is recited in claims 23-49, 53-57, 66 and 70 of copending Application No. 11/226,870. That is claims 23-49, 53-57, 66 and 70 of copending Application No. 11/226,870 fall entirely within the scope of claims 127-158, 166 and 170 or, in other words, claims 127-158, 166 and 170 are anticipated by claims 23-49, 53-57, 66 and 70 of copending Application No. 11/226,870. Specifically, claims 23-49, 53-57, 66 and 70 of copending Application No. 11/226,870 recite pharmaceutical compositions comprising insulin and a ligand that binds reversibly to a His^{B10} Zn^{2+} site of an R state insulin hexamer wherein the ligand has the formula identical to that in claim 127 of the instant application. Claims 159-167, 167-169 and 205-218 overlap in scope with claims 1-43 of copending Application No. 11/226,870 but do not have a precise genus-species relationship with these claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

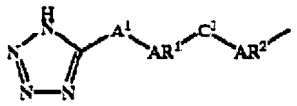
35. Claims 1, 127-170, 205 and 213-218 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 92-120, 137-139, 141-143, 147, 151, 152, 154, 155, 158, 159, 162, 165-173 and 175-186 of copending Application No. 10/332,541 in view of Dunn (U.S. Patent No. 5,830,999). The claims of the copending application are drawn to compounds of formula A-B-C-D-X wherein A is a functionality capable of reversibly coordinating to a His^{B10} Zn^{2+} site of an insulin hexamer and includes compounds of the structure



wherein the variables are defined above. Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} Zn^{2+} sites in insulin stabilize formulations of insulin hexamers for pharmaceutical use (abstract). It would have been obvious to one of ordinary skill in the art to combine the A ligands of copending application 10/332,541 with the insulin hexamers in the absence of the -B-C-D-X moiety. The skilled artisan would have been motivated to do so given that Dunn teaches that ligands for the His^{B10} Zn^{2+} sites stabilize the hexamer form of insulin and the claims of copending Application No. 10/332,541 teach that the A groups bind to the His^{B10} Zn^{2+} sites. There would have been a reasonable expectation of success given that the A compounds are functionally equivalent to the ligands of Dunn. This is a provisional obviousness-type double patenting rejection.

36. Claims 1, 127-170, 205 and 213-218 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 11/227,760 in view of Dunn (U.S. Patent No. 5,830,999). The claims

of the copending application are drawn to compounds of formula CGr-Lnk-Frg1-Frg2-X wherein CGr is a chemical group which reversibly binds to a His^{B10} Zn^{2+} site of an insulin hexamer and includes compounds of the structure



wherein the variables are defined above (the '760 application uses the variables K, M, Q and T instead of A^1, AR^1, C^1, and AR^2 but the genus is equivalent and for simplicity will not be repeated here). Dunn teaches that ligands that bind tightly and specifically to the two His^{B10} Zn^{2+} sites in insulin stabilize formulations of insulin hexamers for pharmaceutical use (abstract). It would have been obvious to one of ordinary skill in the art to combine the CGr ligands of copending application 11/227,760 with the insulin hexamers in the absence of the Lnk-Frg1-Frg2-X moiety. The skilled artisan would have been motivated to do so given that Dunn teaches that ligands for the His^{B10} Zn^{2+} sites stabilize the hexamer form of insulin and the claims of copending Application No. 11/227,760 teach that the CGr groups bind to the His^{B10} Zn^{2+} sites. There would have been a reasonable expectation of success given that the CGr compounds are functionally equivalent to the ligands of Dunn. This is a provisional obviousness-type double patenting rejection.

37. Because Applicant has not presented arguments against these rejections, they are maintained.

Conclusion

38. No claims are allowed.

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Marchetti Bradley whose telephone number is (571) 272-9044. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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